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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,984	08/22/2001	Stuart Leon Soled	GJH-0005	4480

7590

08/08/2006

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EXAMINER

HAILEY, PATRICIA L

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/869,984

Applicant(s)

SOLED ET AL.

Examiner

Patricia L. Hailey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on July 12, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Applicants' remarks and amendments, filed on July 12, 2005, have been carefully considered. No claims have been canceled or added; claims 1-13 remain pending in this application.

Withdrawn Rejections

The provisional obviousness-type double patenting rejection of claims 1-13 as being unpatentable over claims 1-8, 15, and 16 of copending Application Serial No. 09/869,987 has been withdrawn in view of the Terminal Disclaimer filed by Applicants' on July 12, 2005.

New Grounds of Rejection

The following New Grounds of Rejection are being made in view of the newly discovered and/or reconsidered references to Riley et al. (U. S. Patent No. 6,582,590), Hou et al. (U. S. Patent No. 6,712,955), Haluska et al. (U. S. Patent No. 6,755,963), Hantzer et al. (U. S. Patent No. 6,758,963), Mills et al. (U. S. Patent No. 3,619,414), Ho et al. (U. S. Patent No. 5,841,013, cited in an Information Disclosure Statement filed by Applicants on February 5, 2004), and European Patent No. 0 203 228.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,582,590.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both respective sets of claims are directed to a similar hydroprocessing processes which employ the same bulk multimetallic catalyst having a composition as recited in the instant claims. See, in particular, instant claims 1 and 4, and claims 1 and 8-10 of the '590 patent.

Although the claims in the '590 patent are directed to a "multistage hydroprocessing process", the patented process and the instantly claimed process are considered synonymous, as they each recite the steps of treating a feed with hydrogen at comparable process conditions.

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3. Claims 1-13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,755,963.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the respective sets of claims are directed to employing the same or similar bulk multimetallic catalyst recited in the instant claims. The patented claims are directed to a "hydrotreating process for hydrocarbon resin or rosin molecules", whereas the instant claims are directed to "a process for hydroprocessing a petroleum feedstock". However, the respective processes are synonymous, as they each recite the steps of treating a feed with hydrogen at comparable process conditions.

4. Claims 1-13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,712,955.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the respective sets of claims are directed to hydroprocessing processes, each employing the same or similar bulk multimetallic catalyst, as formulaically represented by both the instant claims and the patented claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over either: *Mills et al.* (U. S. Patent No. 3,619,414), *Ho et al.* (U. S. Patent No. 5,841,013), or European Patent No. 0 203 228.

Mills et al. disclose a process for the catalytic hydrofinishing of petroleum distillates in the presence of a catalyst comprising the oxides of: 4-16 wt.% molybdenum, and a combination of about 10-25 wt. % nickel and tungsten. Exemplary process conditions include a temperature range of about 500°F to about 800°F, a LHSV

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ranging between 0.1 and 8, and a pressure ranging between about 500 and 3000 psig.

See the Abstract of Mills et al., as well as col. 2, lines 22-42 and col. 3, line 56 to col. 4, line 23.

Ho et al. disclose a hydrogenation process that uses a highly active aromatic hydrogenation catalyst. Said catalyst comprises a mixed metal oxide catalyst represented by the formula $ML(Mo_yW_{1-y}O_b)_a$, wherein M is chromium (Cr) and/or one or more divalent promoter metals selected from the group consisting of: Mn, Fe, Co, Ni, Cu, and Zn, L is one or more neutral nitrogen-containing ligands (at least one of which is a chelating polydentate ligand), the variable y ranges between 0 and 1 (end points inclusive), and the variable a equals 1 for non-chromium containing catalysts, but ranges between 0.5 and 3 (end points inclusive) for catalysts containing chromium. Process conditions include temperatures of 300°F-800°F, pressures of 100-3000 psig, hydrogen feed rates of 300-3000 SCFB, and LHSV's of 0.5-8.0. See the Abstract of Ho et al., as well as col. 1, lines 35-62 and col. 5, lines 15-22.

The European Patent discloses a process for hydrotreating hydrocarbons, in which a catalyst system arranged in a stacked bed is employed. The catalyst system comprises an upper zone containing up to 10 wt.% of a Group VIII metal compound, and 3-15 wt. % of a Group VIB metal compound, and a lower zone containing up to 10 wt.% of a Group VIII metal compound and from 3-30 wt. % of a Group VIB metal compound. In both the upper and lower zones, the catalysts comprise a nickel and a molybdenum and/or tungsten component. See page 3, lines 31-45, page 4, lines 31-47, and page 5, lines 8-18 of the European Patent. Further, the European Patent, at Table

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1 on page 6 therein, discloses exemplary process conditions comparable to those respectively recited in the instant claims.

Neither of the aforementioned references discloses the molar ratios of Group VIB metal to Group VIII metal, as recited in the instant claims.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the teachings of Mills et al., Ho et al., or the European Patent, such as the respectively disclosed weight percentages of the catalyst components, by determining through routine experimentation the optimum value of the molar ratios (considered result effective variables) of the disclosed catalyst components.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

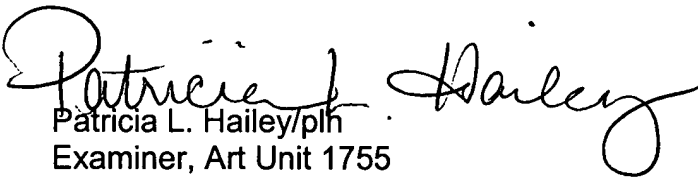
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Hailey whose telephone number is (571) 272-1369. The examiner can normally be reached on Mondays-Fridays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1700 Receptionist, whose telephone number is (571) 272-1700.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Patricia L. Hailey/plh
Examiner, Art Unit 1755
August 4, 2006


J.A. LORENZO
SUPERVISORY PATENT EXAMINER